

PATENT

ATTORNEY DOCKET 044921-5029-01



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

William E. MUNGER *et al.*

Application No. 09/960,706

Filed: September 24, 2001

For: IDENTIFYING DRUGS FOR AND
DIAGNOSIS OF BENIGN PROSTATIC
HYPERPLASIA USING GENE
EXPRESSION PROFILES

Group Art Unit: 1645

Examiner: Unassigned

Commissioner of Patents
BOX MISSING PARTS
Washington, D.C. 20231

RESPONSE TO NOTICE TO FILE MISSING PARTS

1. This replies to the Notice to File Missing Parts of Nonprovisional Application mailed December 26, 2001. A copy of the Notice is enclosed.
2. Declaration Or Oath
 - ☒ No declaration or oath was filed. Enclosed is the original Combined Declaration and Power of Attorney.
 - ☐ The specification attached to the declaration is a copy of the specification and any amendments thereto which were filed in the PTO to obtain the filing date.
 - ☐ The declaration or oath which was filed was determined to be defective. A new original Combined Declaration and Power of Attorney is attached.
3. English Translation of Non-English Language Papers
 - ☐ Submitted herewith is a verified English translation of the non-English language application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the PTO. Also enclosed is the Verification of Translation Document.
4. Small Entity Status
 - ☐ Small entity status under 37 C.F.R. § 1.27 is asserted for the present application.

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5. Extension of Time

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136(a) apply.

- ☒ Applicants petition for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a), for the total number of months checked below:

Total months requested	Fee for extension	[fee for Small Entity]
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 400.00	\$200.00
<input type="checkbox"/> three months	\$ 920.00	\$460.00
<input checked="" type="checkbox"/> four months	\$1,440.00	\$720.00
<input type="checkbox"/> five months	\$1,960.00	\$980.00

Extension of time fee due with this request: \$1,440.00

If an additional extension of time is required, please consider this a Petition therefor.

- ☐ Applicants believe that no extension of time is required. However, in the event applicant has inadvertently overlooked the need for a petition and fee for extension of time, applicants hereby petition for such an extension and requests that any fee therefor be charged to our Deposit Account No. 50-0310.

6. Fee Calculation

					Fee Code
Basic Fee				\$740.00	101/201
	Number Filed	Number Extra	at a Rate of (Lg /Sm Entity)		
Total Claims	54 - 20 =	34	\$18/\$9 each=	\$612.00	103/203
Independent Claims	7 - 3 =	4	\$84/\$42 each=	\$336.00	101/202
Multiple dependent claim(s), if any			\$280/\$140	\$	104/204
SUB-TOTAL =				\$1688.00	
Late Filing Surcharge Fee (37 C.F.R. § 1.16(e))			\$130/\$65	\$130.00	105/205
Extension Fee (37 C.F.R. § 1.17(a)(1)-(5))			\$110/\$55 (1 Month)		115/215
			\$400/\$200 (2 Months)		116/216
			\$920/\$460 (3 Months)		117/217
			\$1440/\$720 (4 Months)		118/218
			\$1960/\$980 (5 Months)	\$1440.00	128/228
SUB-TOTAL =				\$3258.00	
TOTAL FILING FEE =				\$3258.00	

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APPLICATION NO. 09/960,706

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7. Fee Payment

- ☒ Please charge Deposit Account No. 50-0310 in the amount of \$3258.00 representing the total fee due (\$1440.00 for four month extension of time, \$740.00 for the filing fee, \$948.00 for additional claim fees, and \$130.00 late filing surcharge fee).
- ☐ The Commissioner is hereby authorized to charge the total fee due to Deposit Account 50-0310.
- ☒ **Except** for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §1.16 and §1.17 which may be required, or credit any overpayment to Deposit Account No. 50-0310.

8. Additional papers enclosed.

- ☒ Preliminary Amendment
- ☒ Submission of Substitute Drawings: 9 sheets; 9 figures
- ☐ Claim for Priority
- ☐ Certified copy of priority document
- ☒ Information Disclosure Statement
- ☒ Form PTO-1449, without references listed
- ☐ Declaration of Biological Deposit
- ☐ Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.
- ☒ Other: Response to Notice to File Substitute Drawings

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Robert Smyth for *Robert Smyth*
Michael S. Tuscan *RN 50801*
Reg. No. 43,210

Date: June 11, 2002

CUSTOMER NO. 09629
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PATENT
ATTORNEY DOCKET NO. 44921-5029-01-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

William E. MUNGER *et al.*

Application No.: 09/960,706

Filed: September 24, 2001

For: IDENTIFYING DRUGS FOR AND
DIAGNOSIS OF BENIGN PROSTATIC
HYPERPLASIA USING GENE
EXPRESSION PROFILES

Group Art Unit: 1645

Examiner: Unassigned

Commissioner for Patents
Washington, D.C. 20231

Sir:

**RESPONSE TO NOTICE TO FILE SUBSTITUTE DRAWINGS
IN NOTICE TO FILE MISSING PARTS**

To correct the informalities in the drawings and in response to the Notice to File Missing Parts dated December 26, 2001, Applicants submit herewith 9 sheets of substitute drawings, containing figures 1-7.

The two month period of response set in the Notice to File Missing Parts expired on February 26, 2002 and this submission is accompanied by a request for a four month extension of time, extending the period for response to June 26, 2002.

If there are any fees due in connection with the filing of this paper, the Commissioner is hereby authorized to charge any additional fees due to Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136, not accounted for above, such an extension is requested and the fee should also be charged to Deposit Account No. 50-0310.

Respectfully submitted
Morgan, Lewis & Bockius LLP

Dated: **June 11, 2002**

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Robert Smyth for
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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/960,706	09/24/2001	William E. Munger	44921-5029-01

CONFIRMATION NO. 4547

FORMALITIES LETTER



OC000000007230697

009629
MORGAN, LEWIS & BOCKIUS
1800 M STREET NW
WASHINGTON, DC 20036-5869

Date Mailed: 12/26/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.
Applicant must submit \$ 710 to complete the basic filing fee for a non-small entity. If appropriate, applicant may make a written assertion of entitlement to small entity status and pay the small entity filing fee (37 CFR 1.27).
- Total additional claim fee(s) for this application is \$1910.
 - \$1080 for 60 total claims over 20.
 - \$560 for 7 independent claims over 3 .
 - \$270 for multiple dependent claim surcharge.
- The oath or declaration is missing.
A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 2750.**

The application is informal since it does not comply with the regulations for the reason(s) indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- Substitute drawings in compliance with 37 CFR 1.84 because:
 - drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch);

06/14/2002 EAREGAY1 00000038 500310 09960706

01 FC:101 740.00 CH
02 FC:102 336.00 CH
03 FC:103 612.00 CH
04 FC:105 130.00 CH

07/02/2002 YGIZAW 00000008 500310 09960706

01 FC:102 252.00 CH

*A copy of this notice **MUST** be returned with the reply.*



Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE